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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,967	01/22/2004	Gary Martin Zelman	4078	7898
23388	7590	04/26/2005	EXAMINER	
TROJAN LAW OFFICES 9250 WILSHIRE BLVD SUITE 325 BEVERLY HILLS, CA 90212			MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,967

Applicant(s)

ZELMAN, GARY MARTIN

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/28/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 9, 2005 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on Mar. 28, 2005 was filed after the mailing date of the Office action on June 14, 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Amendment

3. The amendment filed Feb. 9, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The limitations "said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 15-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to support for the limitations “said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses” now claimed in the independent claims 15,24-26. Nowhere in the specification provides support for such the limitations. In fact the drawings, particular Fig. 4, show the magnetic material on the auxiliary eyeglasses not only being “capable of fitting below” but also “capable of fitting above” and mating with magnetic material on said conventional eyeglasses because due to the characteristics of the magnetic attractive force, the first magnets fitted above or below the second magnets would provide the same magnetic attractive force. Therefore the magnetic material 26 in Fig. 4 can be capable of fitting above or below and matting with magnetic material on said conventional eyeglasses instead of “capable of fitting solely below” as now claimed. The applicant does not demonstrate how the magnetic material on the auxiliary eyeglasses capable of fitting solely below, but *incapable of fitting above* (emphasized) magnetic material on said conventional eyeglasses.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Chao et al (6,012,811).

The limitations in claim 15 are shown in Chao et al's Fig. 16, column 8, lines 7-21. Chao et al discloses an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising: magnetic material 358 on said auxiliary eyeglasses; said magnetic material 358 capable of fitting below and mating with magnetic material on said conventional eyeglasses, whereby said auxiliary eyeglasses are capable of being removably secured to conventional eyeglasses.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao (5,568,207).

The limitations in claims 1-26 are shown in Chao's Figs. 3-7, column 2, line 33 through column 3, line 10, except for the first (emphasized) magnets of the auxiliary eyeglasses are fitted above the second (emphasized) magnets of conventional eyeglasses instead of said magnetic material (of auxiliary eyeglasses) capable of fitting solely below and mating with magnetic material on said conventional eyeglasses as claimed by the Applicant. Due to the characteristic of the magnetic attractive force, the first magnets capable of fitting above or below the second magnets would provide the same magnetic attractive force. It would have been obvious at the time the invention was made to a person having ordinary skill in this art to attach the auxiliary eyeglasses to the conventional eyeglasses in the Chao reference by fitting the magnetic material below and mating with the magnetic material of the conventional eyeglasses since the magnetic material on the auxiliary eyeglasses not only being "capable of fitting solely below" but also "capable of fitting solely above" and mating with magnetic material on said conventional eyeglasses because due to the characteristics of the magnetic attractive. Such a fitting of the first magnets would not change the scope of the invention in the Chao reference. (See *In re Japike*, 86 USPQ 70 (CCPA 1950) for the difference or shifted location in the device would not change the scope of the invention from the prior art.)

(NOTE: It is advised that the applicant should review the long prosecution of examination in the parent application serial no.: 09/184,694 before amending claims and/or responding to the Office action.)

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al.

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It should be noted that although claim 26 “method claim”, the method steps consist of the broad steps of “providing” and “mating” and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

11. Claims 15-17,24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zider (6,139,141).

Zider discloses in Figs. 1-13, a magnetic clips for attaching auxiliary eyeglasses to conventional eyeglasses comprising: a male part and a female part attached to said auxiliary eyeglasses and said conventional eyeglasses wherein the magnetic material in the male part is capable of fitting below and mating with the magnetic material in the female part or vice versa, whereby said auxiliary eyeglasses are capable of being removably secured to conventional eyeglasses. Zider suggests in the abstract that the male and female parts are permanently attached to the auxiliary eyeglasses and the eyeglass frame. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the device in the Zider reference to form an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising magnetic material on said auxiliary eyeglasses; said magnetic material capable of fitting below and mating with magnetic material on said conventional eyeglasses, whereby said auxiliary eyeglasses are capable of being removably secured to conventional eyeglasses as suggested by Zider for the same purposes as the applicant does.

Regarding claim 26, it should be noted that although claim 26 “method claim”, the method steps consist of the broad steps of “providing” and “mating” and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

Double Patenting

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12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 15-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,550,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention as claimed in claims 15-28 is substantially the same as that in claims 1-6 of the '913 patent. All elements claimed in claims 15-28 in the present patent application are included in claims 1-6 of the '913 patent. These elements in the present application perform the same function as those of the elements in claims 1-6 of the '913 patent. Thus, the invention claimed in claims 15-28 is substantially identical to that in claims 1-6 of the '913 patent.

14. Claims 15-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,139,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention as claimed in claims 15-28 is substantially the same as that in claim 7 of the '142 patent. All elements claimed in claims 15-28 in the present patent application are included in claim 7 of the '142 patent. These elements in the present application perform the same

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function as those of the elements in claim 7 of the '142 patent. Thus, the invention claimed in claims 15-28 is substantially identical to that in claim 7 of the '142 patent.

Response to Arguments

15. Applicant's arguments filed Feb. 9, 2005 have been fully considered but they are not persuasive. The applicant defined his invention in page 8 that "A critical aspect of Applicant's invention, as amended, is that the magnetic material on the auxiliary glasses is capable of fitting solely below the magnetic material on the conventional glasses". The applicant then concludes that "In other words, the magnetic material of the auxiliary glasses is **not required to also be attached from above** to the magnetic material of the conventional glasses for the glasses to hold together". It appears that the applicant is confusing because the meaning of capable fitting solely below is totally different from that of "is not required". In analyzing the Chao et al reference, the applicant concludes that "Thus, in Chao, all of the embodiments described in relation to Fig. 16 **require** that the magnetic material of the auxiliary glasses always attach the conventional glasses from above, sometimes from above and below, and never only from below". The applicant does not discuss how the Chao et al's first magnetic material device is incapable of fitting below the second magnetic material on the conventional eyeglasses. Thus, it appears that the applicant's arguments are not based on what he claimed in claims 15 over the Chao et al reference.

Similarly, It appears that the applicant's arguments are not based on what he claimed in claims 15-17,24-26 over the Zider reference.

In response to the double patenting rejections over the US patent nos.: 6,550,913 and 6,139,142, the applicant argues in page that "To overcome this rejection, Applicant has filed a terminal disclaimer in compliance with 37 CFR 1.321 (c), which is attached to this response." However

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there is no terminal disclaimer filed and/or attached to "this" response filed Feb. 9, 2005. It showed on record that the applicant filed a terminal disclaimer on Sept. 15, 2004 to overcome the double patenting rejection over the US patent no.: 6,705,722, but not 6,550,913 and 6,139,142 because that terminal disclaimer does not disclaim these two patents. Therefore the double patenting rejections over the '913 and '142 patents are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huy Mai
Primary Examiner
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HKM/

April 19, 2005